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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,826	07/31/2001	Sylvia K. Kraemer	4050-001	1773

7590 05/04/2006  
Donald C. Casey  
311 North Washington Street, Suite 100  
Alexandria, VA 22314

EXAMINER
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HARBECK, TIMOTHY M

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/917,826	KRAEMER, SYLVIA K.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Timothy M. Harbeck	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation "at least about one thousand United States Patents," is indefinite, as it does not sufficiently define a range that could be considered "about" one thousand. Is that nine hundred fifty? Nine Hundred? Furthermore the modifier of "at least" is normally used to definitively set a bound and the examiner is unclear how something can be "at least about." For instance would nine hundred and fifty qualify? It is not "at least" one thousand, but it may be considered "about" one thousand. Clarification is necessary. For the purposes of examination the claim has been interpreted as "at least one thousand US Patents," and prior art has been applied using this assumption.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindh (US 2002/0022974 A1).

**Re Claim 1:** Lindh discloses a display of patent information comprising the steps of measuring the diversity and depth of a group of patents or patent portfolio. Lindh states that an object of the invention is to provide means for easily obtaining, categorizing and visualizing information on a group of patents or patent portfolio to aid in the determination of the validity of those patents (Paragraph 0004). Specifically noted is the collection and displaying of the classification of the patents, viewed in a statistical format for easier interpretation (paragraph 0005). Lindh further teaches that bibliographical information including title; access number and or classification code is collected and used by an internal database for analysis with regards to a group of patents (Paragraphs 0027-0030). Lindh also discusses the usefulness of viewing the number of citing patents/patent applications that are referenced to a group of patents as this may indicate the interest in that particular patent and technology (depth as defined by the applicant, See discussion in paragraph 0026 and 0045-0046).

Lindh does not explicitly disclose the step wherein this information is applied as a ratio for purposes of analysis, however all the data pertaining to applicants disclosed ratio is readily available through the use of the method disclosed by Lindh. Furthermore the motivation of the Lindh method is clearly defined as assisting the user in assessing the validity and strength of a collection of patents (portfolio) through the collection of data and the subsequent statistical analysis and display. While not defining the explicit ratios of diversity and depth, the method of Lindh is intentionally open ended

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(Paragraph 0047) to give the user latitude in the way in which they would like to analyze a group of patents. It would have been obvious to anyone skilled in the ordinary art at the time of invention for a user of the Lindh method, should they be so inclined, to easily obtain the information needed for these ratios (as these bits of data have been explicitly disclosed); apply them in the proper context, and even view a statistical representation of the data on a computer screen, so they could efficiently and accurately assess the strength of their portfolio.

**Re Claim 2:** Lindh discloses the claimed method supra and while not explicitly disclosing wherein the portfolio consists of at least one thousand United States patents, however as was discussed in the rejection of claim 1 the method of Lindh is specifically open ended with regards to the data collection and does not explicitly define a minimum or maximum number of patents per group. It would have been obvious to someone skilled in the ordinary art at the time of invention to use the method of Lindh for patent portfolios of over one thousand patents because the method is still very much operable in that range.

**Re Claim 3:** Lindh discloses the claimed method supra and while not explicitly disclosing wherein said valuation is calculated with reference to a base line consisting of all U.S. patents issued from 1976-2000, the method of Lindh does disclose the separating of data over time (paragraph 0048). While not explicitly disclosing the claimed time frame it would have been obvious to anyone skilled in the ordinary art to, in the application of the Lind method, provide any time frame that they deemed appropriate to the data for the purposes of comparison and analysis.

***Response to Arguments***

Applicant's arguments filed 03/03/2006 have been fully considered but they are not persuasive. The applicant has argued that the Lindh reference would not be concerned with publicly owned patents because the purpose of the Lindh invention was to establish a monetary value, or parameters relating to a monetary value. While this statement is true, the Lindh reference is not solely directed toward a monetary valuation. For instance one objective Lindh mentions, which would be relevant to publicly owned patents as defined by the applicant, would be to determine "where most of the research lies (0002)." This statement along with Lindh's numerous mentions of citation and reference indicators in determining the "strength and validity" of a patent portfolio indicate that the "value" of a portfolio is not only formed from on monetary basis but also in terms of the "depth," and "diversity" as those terms are defined by the present applicant (0005; 0026 and 0045-0046). The examiner therefore argues that the Lindh reference would be relevant to a portfolio of publicly owned patents as its value (strength and validity as opposed to monetarily) is readily discernable.

Applicant also argues that there is no teaching for publicly traded patents, however this is a simple subset of the broader set of all patents and Lindh explicitly states that patent data can be obtained and further categorized "in the way the user desires," and that "this enables the user to view the data that is most relevant to the user (0007)." For these reasons the rejection is maintained.

***Conclusion***

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**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

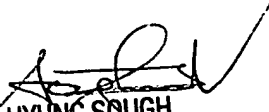
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Harbeck whose telephone number is 571-272-8123. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 571-272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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